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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/759,165	01/16/2001	Veronique Douin	05725.0827-00000	9808

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EXAMINER

WILLIS, MICHAEL A

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 11/05/2002

16

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/759,165

Applicant(s)

DOUIN ET AL.

Examiner

Michael A. Willis

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-- Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 April 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-69 is/are pending in the application.
- 4a) Of the above claim(s) 4-17, 19-24, 26, 27, 29-37, 40-42 and 59-69 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-3, 18, 25, 28, 38, 39 and 43-58 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Applicant's amendment of 16 April 2002 is entered. Claims 1, 57, and 58 are amended. Claims 67-69 are added. Claims 1-69 are pending. Any previous rejections that are not restated in this Office Action are hereby withdrawn. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Election/Restrictions

For reasons as cited in a previous Office Action, claims 4-17, 19-24, 26, 27, 29-37, 40-42, 59-66, and new claims 67-69 are withdrawn from consideration as not reading on the elected invention. Applicant traversed the requirement for restriction and election of species in paper number 8, submitted 19 October 2001. The requirement is still deemed proper and is therefore FINAL, as indicated in paper number 10, mailed 29 January 2002.

Claim Rejections - 35 USC § 103

Claims 1-3, 18, 25, 28, 38, 39, and 43-58 are rejected under 35 USC 103(a) as being unpatentable over Janchipraponvej (US Pat. 4,954,335) in view of Sweger et al (US Pat. 5,482,704) and Martino et al (US Pat. 6,210,689) for reasons as stated previously.

Applicant argues that there is no motivation to modify the teachings of Janchipraponvej '335 with the disclosure found in Sweger '704 so as to obtain applicant's claimed invention. Applicant argues that nowhere in Janchipraponvej '335 is

there any mention of amphoteric starches. The examiner agrees that Janchipraponvej '335 lacks modified starches, but maintains that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In the instant case, the motivation for the modification comes from the secondary reference Sweger '704, rather than the primary reference Janchipraponvej '335.

Applicant argues that Sweger '704 does not remedy the deficiencies of Janchipraponvej '335 in that nowhere in Sweger '704 is there any teaching that modified starches would be desirable additives to the compositions of Janchipraponvej '335. In support, applicant argues that, contrary to Sweger's express statement that CEPA-starch "is actually superior to the Carbopol standard" (col. 9, lines 2-3), Example II of Sweger does not show the superiority of Cepa-starch to Carbopol®. Applicant's argument is based on the fact that the weight percentage of CEPA-starch in the comparison is 2% versus 0.5% for Carbopol® 940, suggesting that the comparison is invalid since the weight percentages differ, and therefore, the conclusions of Sweger do not extend beyond the single example presented therein. The examiner disagrees in that the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208

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USPQ 871 (CCPA 1981). In the instant case, the conclusions of Sweger that CEPA-starch "is actually superior to the Carbopol standard" (col. 9, lines 2-3) would have suggested to one of ordinary skill in the art the desirability of substituting CEPA-starch for Carbopol® as thickeners or emulsion stabilizers in cosmetic compositions for the treatment of skin and hair.

Applicant argues that the prior art teaches away from the use of modified starches in the "clear, homogeneous" hair care compositions of Janchipraponvej '335 because modified starches, when used to make paper, result in paper with increased opacity, as cited in Bernard et al (US Patent 5,500,087). The fact that modified starches have usefulness in papermaking does not exclude their use in cosmetics. As both Janchipraponvej '335 and Sweger '704 are directed to cosmetics, and Bernard '087 is directed to paper-making, the teachings of Bernard '087 cited by applicant are not relevant to one of ordinary skill in the art who is interested in making cosmetics.

Applicant further argues that Martino does not remedy the deficiencies of '335 and '704, since the mere disclosure of the use of alkyl ether sulfate salts as surfactants does not provide the motivation or reasonable expectation of success for the combination of references. However, the missing ingredients have art-recognized suitability for the intended purpose of formulating a cosmetic composition with a surfactant. The selection of a known material based on its suitability for its intended use has been determined to be *prima facie* obvious. See *Sinclair & Carroll Co. v. Interchemical Corp.*, 325 U.S. 327, 65 USPQ 297 (1945); *In re Leshin*, 227 F.2d 197,

125 USPQ 416 (CCPA 1960); and MPEP 2144.07. Absent a showing of unexpected results, the rejection is maintained.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael A. Willis whose telephone number is (703) 305-1679. The examiner can normally be reached on alt. Mondays and Tuesday to Friday (9am-6:30 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on (703) 305-1877. The fax phone numbers for the organization where this application or proceeding is assigned are (703)

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872-9306 for regular communications and (703) 872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.



Michael A. Willis
Examiner
Art Unit 1617

October 24, 2002



SREENI PADMANABHAN
PRIMARY EXAMINER

